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EXAMINER

JOHNSON, STEPHEN

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/738,417  
Filing Date: December 17, 2003  
Appellant(s): HAM, JERRY D.

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James W. Hiney Esq.  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed on 10/14/2008 appealing from the Office action mailed 5/4/2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is substantially correct. However, the "means to deliver CO<sub>2</sub> into the space" does not include hose 13 (see line 8 of applicant's Summary of Claimed Subject Matter section). Rather, the "means to deliver CO<sub>2</sub>" is as described in lines 26-31 of applicant's Summary of Claimed Subject Matter section. Hose 13 is directed to the claim limitations directed to the source of CO<sub>2</sub> gas (see claims 10 and 11).

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

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The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

| U.S. Patent | Inventor   | Issue Date       |
|-------------|------------|------------------|
| 2,813,753   | Roberts    | November 19 1957 |
| 2,857,005   | Medlock    | October 21 1958  |
| 5,651,417   | Coughlin   | July 29 1997     |
| 5,062,486   | McClenahan | November 5 1991  |

#### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 10-15 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts (753) in view of Medlock (005) or Coughlin (417).

Roberts (753) discloses a neutralizing system comprising:

- |  |                                   |
|--|-----------------------------------|
| a) a source of fire suppressant;                     | attached to hose 14               |
| b) manual non-explosive means to create and opening; | 12, 18                            |
| c) a battering ram and hole punch/hollow lance;      | 12, 18                            |
| d) a tank with hose;                                 | 14, supply means attached thereto |
| e) means for delivering the fire suppressant;        | 12                                |
| f) a valve to control flow; and                      | col. 2, lines 44-46               |
| g) openings associated with the lance.               | see fig. 3                        |

Roberts applies as recited above. However, undisclosed is a fire suppressant that is

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carbon dioxide. Medlock (col. 2, line 6) and Coughlin (col. 23, line 8) each teach a fire suppressant that is carbon dioxide. Applicant is substituting one type of fire suppressant for another in an analogous art setting as explicitly encouraged by both the primary (see col. 1, lines 18-19; and col. 3, lines 62-65 of Roberts) and secondary references (see col. 23, lines 1-10 of Coughlin). It would have been obvious to a person of ordinary skill in this art at the time of the invention to apply the teachings of Medlock or Coughlin to the Roberts neutralizing system and have a neutralizing system that uses a different type of fire suppressant material.

2. Claims 10-19 are rejected under 35 U.S.C. 102(b) as being anticipated by McClenahan (486).

McClenahan (486) discloses a neutralizing system comprising:

- a) a source of carbon dioxide and odorant; col. 1, lines 12-22
- b) manual non-explosive means to create and opening; 12, 13, 77, 78
- c) a battering ram and hole punch/hollow lance; 12, 13
- d) a tank with hose; col. 3, lines 36-40
- e) means for delivering the fire suppressant; 12
- f) a valve to control flow; and col. 3, lines 36-40
- g) openings associated with the lance. see figs. 2, 3

3. Claims 10-15 and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Coughlin (417).

Coughlin (417) discloses a neutralizing system comprising:

- a) a source of carbon dioxide an odorant; col. 23, lines 1-10

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- |  |                    |
|--|--------------------|
| b) manual non-explosive means to create and opening; | 41, 43, 19, 23, 24 |
| c) a battering ram and hole punch/hollow lance;      | 19, 41, 51         |
| d) a tank with hose;                                 | 29, 35             |
| e) means for delivering the fire suppressant;        | see figs. 2, 3     |
| f) a valve to control flow; and                      | 37                 |
| g) openings associated with the lance.               | 51                 |

**(10) Response to Argument**

1. Applicant's arguments with regard to the rejection of claims 10-15 and 17-19 being rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts (753) in view of Medlock (005) or Coughlin (417) are addressed as follows. It is argued that Roberts is not directed to an anti-terror device. In response, note that what applicant has claimed is "A CO<sub>2</sub> neutralizing system" and clearly the Roberts device is directed a neutralizing system. The Roberts device neutralizes fires via the active application of water (col. 1, lines 20-46). Also note that one of the most common activities known to terrorist activities is starting fires. As such, Roberts would inherently meet this argument although such argument is not explicitly claimed. It is further argued that there is no reason to modify Roberts to use CO<sub>2</sub>. This argument ignores the facts with regard to the secondary teachings of Medlock and Coughlin (see col. 23, lines 1-10 of Coughlin) and the primary teachings of Roberts (see col. 1, lines 18-19; and col. 3, lines 62-65 of Roberts) providing explicit teachings directed to substituting one type of fire fighting agent for another. Is applicant of the opinion that the only fire fighting agent known in this art is water? With regard to the issue of what hostage situation is being solved, this is not a requirement of the

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combination of references that relies on a substitution of fire fighting agents. However, one hostage situation or terrorist activity would be directed to a terrorist starting a fire. Is applicant of the opinion that terrorist's are not well known to start fires in their terrorist activities? It is further argued that the examiner makes the substitution for a reason having nothing to do with applicant's invention. In response, it is not a requirement that the substitution be made for any particular reason but rather only that it be made as would be obvious to one of ordinary skill in this art. However, fire fighting would be quite useful in many terrorist applications for the reasons already given.

It is further argued that in Medlock there is no ram per se. In response, this is not convincing for several reasons. First, there is no requirement that Medlock teach a ram because this is already taught by Roberts (see fig. 3). Secondly, Medlock does teach a ramming or penetrating device (48, 49). It is further argued that the art to which the subject matter is being applied is not the same. In response, Medlock and Roberts as well as Coughlin are directed to fire fighting. Just because this is not explicitly the same as applicant's reason for using the device does not remove the fact that these references are clearly applied to the same or analogous art. It is further argued that Roberts is not directed to fighting terrorists. Once again applicant is reminded of what is actually being claimed "A CO<sub>2</sub> neutralizing device". Certainly a CO<sub>2</sub> neutralizing device could be used for neutralizing fires and/or for neutralizing fires started by terrorists. Applicant once again argues that he is neutralizing terrorist and not putting out fires even though this is not actually what is claimed and putting out fires would inherently neutralize any terrorist starting a fire. It need not be further addressed. With regard to the basis for combination of the references, this has already been provided.

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2. Applicant's arguments with regard to claims 10-19 being rejected under 35 U.S.C. 102(b) as being anticipated by McClenahan (486) are addressed as follows. It is argued that McClenahan does not teach an odorant associated with the CO<sub>2</sub> associated with fire fighting. In response, col. 1, lines 15-26, of McClenahan references any fire extinguishing fluid known in this art. Note that many of these fire extinguishing fluids as known to one of ordinary skill (see col. 23, lines 1-10 of Coughlin) inherently contain an associated odor. Consequently, McClenahan inherently meets this claim limitation even if no explicit reference to well known fire extinguishing fluids having odor is explicitly mentioned in the reference. Note that odor is any associated smell that can be identified. For instance a device used to sense CO<sub>2</sub> could be used to identify a CO<sub>2</sub> odor. As such, just about any substance has and must have an associated odor that can be identified. It is further argued that there would be no reason to use an identifying odor in a fire suppression device. In response, this rejection is based upon the inherent nature of the materials used and not upon some reason for combination as would be required in a rejection under 35 USC 103. It is further argued that the device pours in CO<sub>2</sub> as associated with fire fighting and such would not be appropriate in a hostage situation. Once again, applicant has claimed "A CO<sub>2</sub> neutralizing device". Further, such a device would inherently also put out any fire as would commonly be started in a terrorist activity. It is further argued that the McClenahan reference does not qualify as "patented or described in a printed publication". In response, note that McClenahan in a U.S. patent issue on November 5, 1991. The arguments directed to a terrorist application have already been addressed. It is argued that there is no reason to modify McClenahan. In response, this argument is not understood in view of the fact that this a rejection under 35 USC 102 and there is no suggested modification either suggested by the examiner or



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required in view of the type of rejection being applied. It is further argued that there is no teaching of an adjustment valve for adjusting the amount of CO<sub>2</sub>. In response, note col. 3, lines 36-40, of McClenahan. With regard to the interpretation of the meets and bounds of the reference, see item 2 in the Grounds of Rejection section.

3. Applicant's arguments with regard to claims 10-15 and 17-19 have being rejected under 35 U.S.C. 102(b) as being anticipated by Coughlin (417) are addressed as follows. It is argued that the CO<sub>2</sub> in Coughlin is used to combat fires. This is accurate. However, Coughlin still meets applicant's claim limitations directed to "A CO<sub>2</sub> neutralizing device". Further, the Coughlin device would inherently act to extinguish any fire set by the terrorists as well as inherently neutralize any terrorist near the fire via the CO<sub>2</sub> forced into the steel bulkhead of Coughlin. Further, there is a control valve present in Coughlin (33, 36, 37) that inherently acts to both the control the application of the CO<sub>2</sub> as well as the amount of applied CO<sub>2</sub>. Further, note that the claims at issue are apparatus or system claims and not method or use claims. These claims have been restricted out and have no relevance with regard to the current application of Coughlin to applicant's claim language. With regard to the issue of the "invention" being "patented or described in a printed publication", note that Coughlin was issued and is available as prior art as of July 29, 1997. Further, the invention is identically disclosed as claimed. It may not be identically disclosed with regard to unclaimed and argued limitations directed to other intended and unclaimed usages. It is argued that Coughlin does not disclose a method of regulating the amount of CO<sub>2</sub>. In response, note that applicant has claimed "an adjustment valve for regulating the amount of gas that flows into said space". Clearly adjustment valve 37 meets this claim limitation (see col. 8, lines 37-39). With regard to the claim limitation directed to an odorant, see

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col. 23, lines 1-10. Note that any chemical that can be sensed via its inherent smell contains an inherent odor even if not specifically stated in the reference.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Stephen M. Johnson/

Primary Examiner, Art Unit 3641

Conferees:

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